

**REMARKS**

Claims 1-12 and 14-18 were pending in this application.

Claims 1-12 and 14-18 have been rejected.

Claims 1, 9-12, and 14 have been amended as shown above.

Claims 19 and 20 have been added.

Claims 1-12 and 14-20 are now pending in this application.

Reconsideration and full allowance of all pending claims are respectfully requested.

**I. OBJECTION TO SPECIFICATION**

The Office Action objects to the specification because of the Applicant's use of the phrase "text to speech" rather than the term "text-to-speech." This objection is respectfully traversed.

Once again, the Applicant notes that the Office Action fails to identify any portion of the Applicant's specification that is actually ambiguous. Instead, the Office Action simply notes that the phrase "text to speech" in the Applicant's specification should be changed to avoid "potential ambiguity." (*Office Action, Page 4, Paragraph 5*). The Office Action fails to identify any specific portion of the specification that is actually unclear or ambiguous.

The Applicant also notes that a person skilled in the art could easily understand the Applicant's specification without any ambiguity. This is supported by the fact that the *Sharman* reference (U.S. Patent No. 5,774,854) cited in the Office Action uses the phrase "text to speech."

Based on this, a person of ordinary skill in the art understands the meaning and scope of this phrase.

Accordingly, the Applicant respectfully requests withdrawal of this objection. However, the Applicant again notes that the Examiner is entitled to enter an Examiner's amendment replacing the phrase "text to speech" with the term "text-to-speech" at appropriate locations in the specification.

## II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claim 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,774,854 to Sharman ("*Sharman*"). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Claim 6 recites the use of a "vocabulary of textual units." When a "parsed textual unit" corresponds to a stored textual unit in the vocabulary, the stored textual unit is added to a "list." Each parsed textual unit represents "a word, a prefix or a suffix."

The Office Action acknowledges that *Sharman* converts text into words, divides the words into syllables, and processes the syllables. (*Office Action, Pages 4-5, Paragraph 6*). The

Office Action specifically states that *Sharman* uses a dictionary when performing “syllabication” (converting words into syllables). (*Office Action, Page 4, Paragraph 6*).

The Office Action assumes that the dictionary of *Sharman* anticipates the “vocabulary of textual units” recited in Claim 6. However, the Office Action only shows that *Sharman* uses the dictionary to break words into syllables. As a result, the Office Action only shows that *Sharman* uses the dictionary to generate a list of syllables. The Office Action fails to show that *Sharman* uses the dictionary to place “textual units” in a list, where each textual unit represents “a word, a prefix or a suffix.” In particular, the Office Action fails to show that *Sharman* generates a list of words, prefixes, and/or suffixes using the dictionary.

The Office Action asserts that a “syllabified word” (a word broken into its constituent syllables) in *Sharman* anticipates the “list” recited in Claim 6. In effect, the Office Action is asserting that a list of syllables in *Sharman* anticipates a list of textual units, or that each syllable in *Sharman* represents a “textual unit” as recited in Claim 6. However, this is an improper interpretation of Claim 6. Claim 6 clearly recites that a “textual unit” represents “one of a word, a prefix or a suffix.” As a result, the Office Action’s reliance on a list of syllables from a single word in *Sharman* to anticipate a “list” of textual units recited in Claim 6 is improper.

For these reasons, the Office Action fails to show that *Sharman* anticipates the Applicant’s invention recited in Claim 6. Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claim 6.

**III. REJECTION UNDER 35 U.S.C. § 103**

The Office Action rejects Claims 1-5, 9-12, 14-15, and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Sharman* in view of U.S. Patent No. 5,878,393 by Hata et al. ("*Hata*"). The Office Action rejects Claims 7 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Sharman* in view of "Computer Dictionary," Microsoft Press ("*Dictionary*"). The Office Action rejects Claims 8 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Sharman* in view of O'Donnell, "Programming for the Real World – A Guide to Internationalization" ("*O'Donnell*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Regarding Claims 7, 8, and 16, Claim 6 is patentable over *Sharman* as explained above. As a result, Claims 7, 8, and 16 are patentable due to their dependence from an allowable base claim.

Regarding Claims 1 and 9-12, the Office Action acknowledges that *Sharman* generates sounds by (1) converting text into words, words into syllables, and syllables into phonemes, and (2) using the phonemes to generate an audio waveform. (*Office Action, Page 6, Paragraph 7*). However, *Sharman* does not disclose, teach, or suggest generating a list of “words, prefixes, and suffixes” and then locating a “speech sample” associated with each word, prefix, or suffix as recited in Claims 1 and 9-12.

Moreover, *Hata* fails to disclose, teach, or suggest these elements of Claims 1 and 9-12. *Hata* recites a concatenative reading system. (*Abstract*). The system uses a dictionary of

sampled sounds to produce an audio signal, where the dictionary has entries for individual words or for phonemes. (*Col. 3, Lines 42-64*). An example dictionary including the words “dollars” and “cents” is shown in Figure 3.

*Hata* fails to disclose, teach, or suggest generating a list of “words, prefixes, and suffixes” as recited in Claims 1 and 9-12. Instead, *Hata* simply recites generating a list of words. *Hata* also fails to disclose, teach, or suggest locating a “speech sample” associated with each word, prefix, or suffix as recited in Claims 1 and 9-12. As shown in Figure 3 of *Hata*, the word “dollars” is associated with a sample, and the word “cents” is associated with a sample. Each of these words actually includes a word (“dollar” or “cent”) followed by a suffix (“s”). As a result, *Hata* does not locate a “speech sample” associated with each word, prefix, or suffix in a list. ✓

Regarding Claim 14, *Sharman* and *Hata* both fail to disclose, teach, or suggest a data structure that includes a field for a “frequency of a first portion of the speech sample that exceeds an amplitude threshold” and a field for a “frequency of a last portion of the speech sample that exceeds the amplitude threshold” as recited in Claim 14.

For these reasons, the Office Action fails to show that the proposed *Sharman-Hata* combination discloses, teaches, or suggests all elements of Claims 1, 9-12, and 14 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1-5, 7-12, and 14-18

IV. NEW CLAIMS

The Applicant has added new Claims 19 and 20. The Applicant respectfully submits that no new matter has been added. At a minimum, Claims 19 and 20 are allowable due to their dependence from an allowable base claim. The Applicant respectfully requests entry and allowance of Claims 19 and 20.

V. CONCLUSION

As a result of the foregoing, the Applicant asserts that the claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208. No extension of time is believed to be necessary. If an extension of time is needed, however, the extension is requested. Please charge the fee for the extension to Deposit Account No. 50-0208.

Respectfully submitted,

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